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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/533,650

11/25/2005

Haruo Wakayama

YAMAP0979US

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11/13/2008

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EXAMINER

MICHALSKI, SEAN M

ART UNIT

PAPER NUMBER

3724

MAIL DATE

DELIVERY MODE

11/13/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

ADVISORY ACTION

1. The amendment to the claims is presented to overcome a 112 rejection, and the amendment returns the claim to a state previously examined. They clarify the meaning of the scope somewhat and will be entered for purposes of appeal.

Applicant alleges that Ishikawa does not disclose an abrupt impact force, since the cutting tip does not leave the surface. This is not contradictory- for example, envision your hand on a table, and then envision hitting it with your other hand; hand one is certainly applying an “abrupt impact” to the table, regardless of it’s previous contact therewith. Impact relates to force, and not only to contact. Impact does not necessarily require positional change. The standard of claim interpretation during prosecution is as follows: “claims in a pending application should be given their broadest reasonable interpretation” consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control.

2. Applicant alleges that Hoeksrtra and Ishikawa are not combinable, since they are “different”. Examiner agrees that they are different, however, Hoekstra uses a scribe wheel, not “laser scribing”, and is within the same field of endeavor. A person of

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ordinary skill does not blind himself to nearby inventions just because they are slightly different than the exact invention/ mode of solution/problem at hand.

Applicant alleges that Insolio teaches away from the present invention because of the manner in which the abrupt impact is applied. Examiner has demonstrated that within the scope of the claims, Insolio meets the limitations “abrupt impact” because of the “abrupt impact” that is applied when the full voltage is applied. Just because applicant’s “abrupt impact” is different than that shown by examiner does not mean that the “abrupt impact” of the prior art is not applicable to the claims. The standard of claim interpretation during prosecution is as follows: “claims in a pending application should be given their broadest reasonable interpretation” consistent with the specification and prior art. In re Pearson , 181 USPQ 641 (CCPA 1974). See additionally MPEP 904.01, and also In re Morris, 127 F.3d 1048, 44 USPQ2d 1023 (Fed. Cir. 1997). It has been established that during examination, where applicant has the ability to amend claims, the standard of claim interpretation is that the broadest reasonable interpretation be given to all the terms of a claim, *absent a specific definition provided in the specification*, which would then control.

3. The statement of intended use “for applying an abrupt impact force to the vertical crack forming member in order to generate a vertical crack” has been given patentable weight insofar as the recited impact force applying means must be *capable of* applying an abrupt impact force. This claim interpretation is mandated in MPEP 2106 II C which states “Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a

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claim or claim limitation. The following are examples of language that may raise a question as to the limiting effect of the language in a claim: (A) statements of intended use or field of use.” **Since** the structure of the applied art both *does* and **is capable of** applying an abrupt impact force, generating a vertical crack etc. It meets the limitations of the claims. *Capabilities* of prior art structures do not need to be explicitly disclosed to be present in the prior art.

4. The rejections as set forth 9/8/08 are maintained, the arguments presented being deemed wholly and individually non-persuasive.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SEAN M. MICHALSKI whose telephone number is (571)272-6752. The examiner can normally be reached on M-F 7:30AM - 3:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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/Sean M Michalski/
Examiner, Art Unit 3724

/Kenneth Peterson/
Primary Examiner, Art Unit 3724